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EXAMINER

LEVINE, ADAM L

ART UNIT

PAPER NUMBER

3625

NOTIFICATION DATE

DELIVERY MODE

03/21/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/649,039

Applicant(s)

KERNZ, JAMES J.

Examiner

ADAM LEVINE

Art Unit

3625

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 59-78 and 81-93 is/are pending in the application.
- 4a) Of the above claim(s) 67 and 68 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 59-66, 69-78 and 81-93 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

Applicant's amendments and remarks filed December 20, 2007, are responsive to the office action mailed August 23, 2007. Claims 59,70, 75, and 81 have been amended. Claims 1-58 and 79-80 were previously cancelled. Claims 67 and 68 were previously withdrawn. Claims 59-78 and 81-93 are therefore currently pending and claims 59-66,69-78, and 81-93 are examined in this office action.

Response to Arguments

Applicant's arguments filed December 20, 2007, have been fully considered but they are not persuasive.

Pertaining to rejections under 35 USC §103(a)

Applicant argues that "assigning a unique identifying indicia to the object" (or "coin") is not present in Paskowitz. Before embarking on a more detailed consideration of applicant's arguments it may be helpful to first note that "assigning a unique identifying indicia" as disclosed in the present application refers to giving an item an identifier. A name, symbol, alphanumeric string, or other designation that identifies one object alone from among all other objects. The exact form of the identifier, whether it be symbolic, or alphanumeric, a barcode, a color code, etc., is not relevant as the distinction between these variations would all be nonfunctional. Regardless of the form taken by the unique identifying indicia the function is to identify the object. It is therefore

here noted that the examiner considers "assigning a unique identifying indicia" to an object to distinguish it from other objects in commerce is old and well known. Examiner believes that applicant will realize this, but the examiner also believes that the element is present in the prior art currently being scrutinized.

Applicant argues that because the identifying indicia in the prior art is based on the intrinsic qualities of the object being identified that it is therefore not "assigned" and that there is no suggestion that it is "unique." The fact that the identifying indicia is ultimately based on the item's characteristics does not mean the identifying indicia is not assigned. It is assigned based on the item's characteristics (see at least Paskowitz fig.5). This is an improvement that the present prior art teaches over the preceding prior art. The present prior art (Paskowitz) discusses the preceding prior art including "storekeeping units (SKUs)." One difficulty in the prior art discussed by Paskowitz is that two instances of the same product can have different SKUs. The scheme of Paskowitz would give the same product the same identifier (see at least Paskowitz column 8 lines 53-60). This does not mean that Paskowitz teaches away, however, because the use of SKUs is still compatible with Paskowitz. It does however disclose the assignment of unique identifying indicia that do not represent the characteristics of the object, in the art even prior to Paskowitz, and in this case even for two objects that are actually the same basic product. This also clarifies that not only is there a suggestion in Paskowitz that the identifier is unique, in fact the only thing required in Paskowitz for the assignment of a unique identifier is for the object to actually be unique.

Finally it is noted that, where an object is given a unique identifying indicia, the indicia represents the object and thus the characteristics that are embodied by the object whether or not the indicia was originally derived based on the object's specific characteristics. In fact the indicia itself can be considered a characteristic of the object.

In response to applicant's argument that the present application is directed to the assignment of unique identifying indicia to a single object, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art is capable of performing the intended use, then it meets the claim. As noted above, if the object is unique, then the prior art would assign a unique identifying indicia.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Mayer, not Paskowitz, discloses "a tamper-evident holder." Paskowitz, not Mayer, discloses a "unique identifying indicia."

Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the claims, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the

references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 1. Claims 59-66,69-78, and 81-93 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The phrase "assigning a unique identifying indicia to the object, which unique identifying indicia does not represent the characteristics of the object" in claims 159,70,75, and 81 is used by the claim to mean that the system of nomenclature used to generate the indicia assigned to the object is not based on the individual descriptive characteristics of the object. Unfortunately, since the indicia identifies the object, it must be associated with all of the characteristics that define the object, and in fact the indicia itself is also potentially a characteristic. As a result the language appears self-contradictory and would only make sense to an individual who first referred to the

Art Unit: 3625

prosecution history of this application and the prior art that applicant is attempting to avoid in sculpting these claims. The term is indefinite because the specification does not clearly redefine the concept.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 59-66,69-78, and 81-93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paskowitz (Paper #20060904; US Patent No. 6,377,937) in view of Mayer (Paper #20060904; US Patent No. 5,042,650) and further in view of Klearman (US Patent No. 5,311,365).

Paskowitz teaches a method and system for grading and commoditizing objects, making them trade ready. Paskowitz teaches grading an object based upon a predetermined grading scale and generating a grade indicator for the object (see at least abstract, figs.1-6, column 3 lines 20-30, column 6 lines 32-58). Paskowitz teaches commoditizing the object by generating relevant textual trade data for the object and storing the relevant textual trade data in a database in a form for use in generating a trade listing for the object (see at least abstract, figs.3,5; column 1 lines 16-34, column 6 lines 32-58, column 8 lines 32-47, line 65 - column 9 line 9). Paskowitz further teaches:

- performing these steps for a plurality of objects: providing access to the relevant textual trade data in the database to sellers to generate trade listings for the objects (see at least abstract, column 6 lines 32-58); providing access to the trade listings to the sellers and to buyers within an online peer-to-peer trading environment (see at least figs.1,6; column 1 lines 8-14, column 2 lines 50-64).
- assigning a unique identifying indicia to the object: which unique identifying indicia does not represent the characteristics of the object (see at least fig.5, column 8 lines 53-60, column 9 lines 49-66. Please note: an indicia that represents an object without representing the characteristics of the object is merely an exercise in semantics, since even the indicia itself is a characteristic of the object. In addition, the form or origin of the indicia is nonfunctional. It is merely the fact that the indicia exists and what it is used for that bear the function. Because the descriptive material related nature or form of the indicia is not functionally involved in the recited steps of the method it will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381 , 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). MPEP 2106.); connecting the database to a host computer, connecting a remote terminal to the host computer, sending the unique identifying indicia from the remote terminal to the host computer and retrieving from the database for viewing at the remote terminal the relevant textual or digitized image trade data for the object associated with the unique identifying indicia, providing relevant trade data to at least one online trade enabling facility (see at least fig.2, column 1 lines 8-14,

column 3 lines 20-30, 50-59 (retrieving and displaying product information through the internet inherently involves a remote computer retrieving information from a database through a host computer), column 9 lines 48-60. The image or text data is descriptive material and is not functionally involved in the recited steps of the method. Because it has no functional role in the method it is non-functional descriptive material. This descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). MPEP 2106). The provision of the data described can occur either in advance or contemporaneous with the trade listing); each of the unique identifying indicia is an assigned unique certificate number having a predetermined format (Please note: the format of the identifying indicia is descriptive material and is not functionally involved in the recited steps of the method. Because it has no functional role in the method it is non-functional descriptive material. This descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). MPEP 2106).).

- the object is at least one of a coin, a stamp, a trading card, currency and a document: the stored relevant textual trade data is at least one of a plurality of item specific attributes including a certificate number, a year of mintage indicator, a Mint branch indicator, a denomination indicator, type designation, grade indicator, and grading firm identifier (Please note: in the context of this invention, the nature of the objects only affects the information presented within the

descriptive material. It has no actual role in the method. The description of the object is therefore descriptive material and is not functionally involved in the recited steps of the method. Because it has no functional role in the method it is non-functional descriptive material. This descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). MPEP 2106).

- generating trade listings: from the stored relevant textual trade data in at least one trade enabling marketplace computer and providing access to the trade listings to the sellers and to buyers of the objects through computers connected to the marketplace computer (see at least abstract, figs.1,3,5,6; column 1 lines 8-34, column 2 lines 50-64, column 6 lines 32-58, column 8 lines 32-47, line 65 - column 9 line 9).

Paskowitz teaches all of the above as noted and teaches a) associating the grade indicator with the object, b) assigning a unique identifying indicia to each of the objects, and c) a method of communicating data concerning the objects between buyers and sellers. Paskowitz however does not disclose encapsulating objects, associating the grade indicator with the object in a substantially permanent manner by encapsulating the object and a visual representation of the grade indicator in a tamper-evident holder and associating the assigned unique identifying indicia with the object encapsulated in the tamper-evident holder in a substantially permanent manner, printing the assigned associated unique identifying indicia onto a label and securing the printed label within the tamper-evident holder. Mayer teaches a) associating the grade

indicator with the object, b) assigning a unique identifying indicia to each of the objects, and c) a method of communicating data concerning the objects between buyers and sellers. Mayer also teaches encapsulating objects, associating the grade indicator with the object in a substantially permanent manner by encapsulating the object and a visual representation of the grade indicator in a tamper-evident holder, assigning a unique identifying indicia to the object and associating the assigned unique identifying indicia with the object encapsulated in the tamper-evident holder in a substantially permanent manner, printing the assigned associated unique identifying indicia onto a label and securing the printed label within the tamper-evident holder, indicia being visibly conspicuous thereby indicating that the objects are trade ready (see at least abstract, figs.1-5). Mayer further teaches:

- providing a substantially planar upper enclosure element for receiving at least partially a coin retaining insert: (see at least abstract, figs.1-5).
- providing a substantially planar lower enclosure for receiving at least partially a coin retaining insert: (see at least abstract, figs.1-5).
- providing a coin retaining insert adapted for close fitting between the upper and the lower enclosure element: the coin retaining insert having an appropriately dimensioned aperture for confining the coin: (see at least abstract, figs.1-5).
- mounting the coin within the aperture of the coin retaining insert: (see at least abstract, figs.1-5).
- confining the insert including the coin between the upper and lower enclosure elements: (see at least abstract, figs.1-5).

- sealing the enclosure elements using sonic welding means: (see at least abstract, column 3 lines 51-68).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method and system of Paskowitz to include encapsulating objects, associating the grade indicator with the object in a substantially permanent manner by encapsulating the object and a visual representation of the grade indicator in a tamper-evident holder, assigning a unique identifying indicia to each of the objects and associating the assigned unique identifying indicia with the corresponding one of the objects encapsulated in the holder in a substantially permanent manner, printing the assigned associated unique identifying indicia onto a label and securing the printed label within the tamper-evident holder, the indicia being visibly conspicuous, as taught by Mayer, in order to verify the authenticity and value of the object being sold or traded, increasing confidence in the objects traded through the method and system and correspondingly increasing the use of the method and system in commerce.

Paskowitz in view of Mayer teach all of the above as noted and teach a) buying and selling objects in commerce, b) examining an object for the purpose of assigning a value, and c) associating a grade indicator with an object, but do not disclose preparing an object for grading and encapsulation by establishing close physical proximity to the object and enabling visual inspection of the object utilizing at least one of a jeweler's loupe and a magnifying glass, and generating a grade indicator for the object by evaluating a physical condition of the object including characteristics upon which the object is to be graded and visually examining the characteristics of the object to

determine a grade of the object based upon a predetermined grading scale. Klearman teaches a) buying and selling objects in commerce, b) examining an object for the purpose of assigning a value, and c) associating a grade indicator with an object, and also teaches preparing an object for grading and encapsulation by establishing close physical proximity to the object and enabling visual inspection of the object utilizing at least one of a jeweler's loupe and a magnifying glass, and generating a grade indicator for the object by evaluating a physical condition of the object including characteristics upon which the object is to be graded and visually examining the characteristics of the object to determine a grade of the object based upon a predetermined grading scale (see at least abstract, column 1 lines 5-44). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method and system of Paskowitz in view of Mayer to further include preparing an object for grading and encapsulation by establishing close physical proximity to the object and enabling visual inspection of the object utilizing at least one of a jeweler's loupe and a magnifying glass, and generating a grade indicator for the object by evaluating a physical condition of the object including characteristics upon which the object is to be graded and visually examining the characteristics of the object to determine a grade of the object based upon a predetermined grading scale, as taught by Klearman, in order to create value in the items to be bought and sold in commerce, without which Paskowitz in view of Mayer would not be able to function in commerce.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **ADAM LEVINE** whose telephone number is (571)272-8122. The examiner can normally be reached on **M-F, 8:30-5:00 Eastern**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571.272.6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Adam Levine
Patent Examiner
March 12, 2008

/Yogesh C Garg/
Primary Examiner, Art Unit 3625